

REMARKS

Claims 1-19 are pending in the application.

Claims 1-19 have been rejected.

I. **REJECTION UNDER 35 U.S.C. § 102**

Claims 1-7 and 12-14 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,943,055 (Sylvan). The rejection is respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

With respect to independent Claim 1, the Office Action asserts that (1) the computer system on which the messaging system of Sylvan is based would inherently have memory wherein any information regarding the messages would be stored, thereby identically showing the Applicant's memory means for storing notification status for messages in a messaging system, and (2) Figure 2 of the Sylvan reference shows a list describing recently received incoming messages, thereby identically teaching a list of new messages for which a notification has not been cleared. In fact, the Sylvan reference recites that the following list of stored information is presented to the user for each message: type of mail, name of sender, date and time of receipt, and originating telephone number. See Sylvan, Col. 6, lines 59-62. Absent from

the list of stored information disclosed for each message is a notification status for messages. Furthermore, Sylvan presents its user with a list of all received mail messages, rather than a list of messages for which a notification has not been cleared. See Sylvan, Col. 4, lines 53-56.

Applicant respectfully submits that Sylvan fails to identically disclose Applicant's recited elements/features of (1) memory means for storing notification status for messages in a messaging system, and (2) a user interface for providing to a user a list of new messages for which a notification has not been cleared. Accordingly, Sylvan fails to show each and every element of Applicant's claimed invention, arranged as they are in independent Claim 1 (and Claims 2-7, 12 and 13 depending therefrom).

With respect to independent Claim 14, the Office Action asserts that Sylvan Figure 2 and Column 6, lines 51-64, identically shows Applicant's step of identifying a set of messages for which a notification has not been cleared. In fact, the cited passage teaches a window displaying an incoming mail list, which is described at Col. 4, lines 54-56, as "the list of messages received through voice mail, email or fax mail." Thus, Applicant respectfully submits that the cited passage of Sylvan fails to identically disclose Applicant's recited elements/features of identifying a set of messages for which a notification has not been cleared. As such, Sylvan fails to show each and every element of Applicant's claimed invention, arranged as they are in independent Claim 14.

Accordingly, the Applicant respectfully requests withdrawal of the § 102(b) rejection of Claims 1-7 and 12-14.

II. REJECTION UNDER 35 U.S.C. § 103

Claims 8-11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sylvan in view of U.S. Patent No. 6,181,837 B1 (Cahill et al.). Claims 15-19 were rejected under § 103(a) as being unpatentable over Sylvan in view of "Background Polling" (Eric Miller). The rejections are respectfully traversed.

Claims 8-11 depend directly or indirectly from independent Claim 1. As described above, Sylvan fails to show each and every element of Applicant's claimed invention, arranged as they are in independent Claim 1. As a result, Claims 8-11 are patentable due to their dependence from an allowable base claim.

With respect to independent Claims 15 and 18, the Office Action asserts that the Sylvan reference teaches Applicant's elements of (1) memory means for storing notification status for messages, and (2) a list of new messages for which a notification has not been cleared. As described above with respect to Claim 1, Sylvan fails to show these elements and, therefore, the prior art references when combined do not teach or suggest all the claim elements of independent Claims 15 and 18 (and Claim 16, depending from Claim 15). As such, a *prima facie* case of obviousness has not been established.

With respect to independent Claims 17 and 19, the Office Action asserts that Sylvan teaches Applicant's step of identifying a set of messages for which a notification has not been cleared. As described above with respect to Claim 14, Sylvan fails to show this element and, therefore, the prior art references when combined do not teach or suggest all the claim elements

of independent Claims 17 and 19. As such, a *prima facie* case of obviousness has not been established.

Accordingly, the Applicant respectfully requests withdrawal of the § 103(a) rejections of Claims 8-11 and 15-19.

III. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

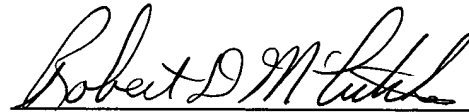
If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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